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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,978	02/26/2004	John C. Subelka	LDC-791 3DIV	4493

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EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/786,978	Applicant(s) SUBELKA ET AL.	
	Examiner Tae H. Yoon	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 15 and 16 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 2 of prior U.S. Patent No. 6,696,507. This is a double patenting rejection.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-8, 10-12 and 17-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ratcliffe et al (US 4,407,984).

Ratcliffe et al teach the instant photocurable dental composition in example 2 wherein the filler C has a mean size of 0.02 μm . The particle size distribution of the filler A in said example 2 is seen in Fig. 1 wherein particle size of 0.50 to 1.0 μm and 1.0 to 8.0 μm are seen. Said particle size meets the instant particle size since the instant claims are silent as to amounts thereof. Fumed silica and barium aluminum silicate is taught at col. 3., lines 48 and 67.

Thus, the instant invention lacks novelty.

Claims 1-8, 10-12 and 17-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yearn et al (US 5,356,951).

Yearn et al teach the instant dental composition in table 1 and at col. 6, lines 1-12. Colloidal silica, R-972, inherently has a particle size of 0.016 μm . Butane moiety containing monomer is taught at col. 5, line 24. Barium glass powders taught at top of col. 6 inherently contain aluminum or strontium borosilicate inherently since glass contain many different metals.

Thus, the instant invention lacks novelty.

Claims 1, 2, 4-12 and 17-19 are rejected under 35 U.S.C. 103(a) as obvious over Ratcliffe et al (US 4,407,984).

The instant invention further recites different amounts of filler over Ratcliffe et al.

But, it would have been obvious to one skilled in the art at the time of invention to utilize the instant amounts of fillers since Ratcliffe et al teach employing various amounts of fillers at col. 3 and in examples absent showing otherwise.

Claims 1-12 and 17-19 are rejected under 35 U.S.C. 103(a) as obvious over Yearn et al (US 5,356,951) and AEROSIL publication from DeGussa.

The instant invention further recites different amounts of filler over Yearn et al. AEROSIL publication shows that R-972 has a particle size of 16 nm (0.016 μm) supporting the examiner's position in above.

But, it would have been obvious to one skilled in the art at the time of invention to utilize the instant amounts of fillers since Yearn et al teach employing various amounts of fillers in bridging gparagraph at cols. 3 and 4 and in table 1, and AEROSIL publication shows that R-972 taught by Yearn et al has a particle size of 16 nm absent showing otherwise.

Claims 1, 2, 4-14 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ratcliffe et al (US 4,407,984) in view of WO 92/08419 or DE 3416083 A1.

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The instant invention further recites a container for the dental composition over Ratcliffe et al. But, said container such as unit dose package is well known in the art as taught by figures of WO and DE. WO (polystyrene, page 2, line 21, polyethylene, page 5, line 32, and polyester, cpage 6, line 13) and DE (polyethylene, page 12, line 14) also teach various polymers for the container.

It would have been obvious to one skilled in the art at the time of invention to pack the photocurable dental composition of Ratcliffe et al with the unit dose package of WO or DE since such packaging is well known in the art absent showing otherwise.

Claims 1-14 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yearn et al (US 5,356,951) in view of WO 92/08419 or DE 3416083 A1.

The instant invention further recites a container for the dental composition over Yearn et al. But, said container such as unit dose package is well known in the art as taught by figures of WO and DE. WO (polystyrene, page 2, line 21, polyethylene, page 5, line 32, and polyester, cpage 6, line 13) and DE (polyethylene, page 12, line 14) also teach various polymers for the container.

It would have been obvious to one skilled in the art at the time of invention to pack the photocurable dental composition of Yearn et al with the unit dose package of WO or DE since such packaging is well known in the art absent showing otherwise.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tae H Yoon
Primary Examiner
Art Unit 1714

THY/November 27, 2006